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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,437	04/23/2001	Tadamasa Kitsukawa	50P4416	4173
7590	03/23/2005		EXAMINER	
John L. Rogitz Rogitz & Associates Suite 3120 750 B Street San Diego, CA 92101			SRIVASTAVA, VIVEK	
			ART UNIT	PAPER NUMBER
			2611	
			DATE MAILED: 03/23/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/840,437	KITSUKAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vivek Srivastava	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____ .   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: ____ .                                   |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1, 4, 11 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

**Claims 1, 4, 11 and 19** recites displaying the gateway screen when the interactive television is turned off. The specification fails to describe how the gateway screen can or is displayed when the television is turned off.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 – 3, 7 – 10, 14 – 18, 23 and 25 - 27 rejected under 35 U.S.C. 102(e)  
as being anticipated by Kikinis (5,929,849).**

**Regarding claims 1, 2,** Kikinis discloses a gateway screen (fig 2c) for a interactive television 51 (fig 1) comprising at least one television content panel 55 and at least one internet content panel 71 (see fig 2c). It is noted that the television content and internet content is simultaneously displayed when the television is turned on.

**Claim 3** is met by the discussions above.

**Regarding claims 7 and 8,** It is noted that the interactive television receives information from the web server and a television signal source (see fig 1 and col 5 lines 26 – col 6 line 32, signal is inherently received from CATV headend).

**Regarding claim 9,** Kikinis discloses an interactive television system comprising a web server (col 6 lines 10-12), at least one interactive television server (server coupled to ISDN 39 and line 41, and at least one television source providing television signals via CATV 17 (see fig 1). It is noted that the interactive television receives information from the web server, the interactive television server and the television signal source (see fig 1 and col 5 lines 26 – col 6 line 32). It is further noted that the interactive television periodically displays gateway screen (fig 2c), the gateway region having at least one television content region 55 and internet region 71, periodically, when user selects the BMW to receive internet information.

**Regarding claim 10,** it is noted that the gateway screen (fig 2c) is displayed when the interactive television is turned on.

**Regarding claims 14 and 15,** Kikinis discloses television content region 55 displaying advertising from television signal source (inherently from CATV headend, also see col 6 lines 64 – 67) and internet content region 71 displaying content from a web server (see col 6 lines 10-12).

**Claims 16 – 18** are met by the discussions above.

**Regarding claim 23,** Kikinis discloses a remote control 63 (see col 17 – 32) for selecting the BMW emblem to display the gateway screen (fig 2c) based on the user input.

**Regarding claims 25 – 26,** Kikinis discloses displaying BMW web page concurrently with the real time broadcasted BMW commercial and thus discloses the claimed the internet content panel is related to content in the television content panel and wherein content in the television content panel is received real-time from a broadcast.

**Regarding claim 27,** Kikinis discloses the claimed storage associated with the television (see VRAM – col 5 lines 48 – 55).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 4 – 6, 11 – 13, 19 – 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (5,929,849).**

**Regarding claim 4,** Kikinis fails to disclose the claimed wherein the gateway screen is displayed when the interactive television is turned off.

Official notice is taken the use of external displays to supplement a television display is well known to provide a more mobile means for viewing information. For example, in the television art, it is well known to display television information on external display i.e. remote control, or computer, or PDA. It would have been obvious providing an external display would have provided an additional means for displaying television information even when the television is turned off. Therefore, it would have been obvious to one having ordinary skill in the art to modify Kikinis to include the claimed limitation to provide information on a mobile or additional display noting that the information can be displayed when the television is turned off.

**Regarding claims 5 and 6,** Kikinis fails to disclose the claimed gateway screen button and the gateway screen is displayed when the gateway screen button is toggled and the claimed remote control unit, the remote control unit having a gateway screen button and the gateway screen button is displayed when the gateway screen button is toggled.

Official notice is taken it is well known to include a television remote control with an internet button to provide a direct connection to a internet gateway screen. Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to modify Kikinis to include the claimed limitation to provide a quick and direct connection to a internet gateway screen.

**Claims 11 - 13** are met by the discussions above.

**Claims 19 – 22** are met by the discussions above.

**Regarding claim 24**, Kikinis fails to disclose the claimed wherein the gateway screen is stored in a memory within an interactive television.

Official notice is taken storing information in local television enables information to be readily available and eliminates the need for an external memory. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kikinis to include the claimed limitation to have information readily available and to eliminate the need for an external memory.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Knudson et al (6,526,577) – Enhanced EPG

Narayan et al (6,859,937) – Context – sensitive options panel

Ward, III et al (6,756,997) – Multi-panel EPG

Legall et al (6,005,565) – EPG displaying internet panel and video panel

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (703) 305-4038. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs  
3/17/05



VIVEK SRIVASTAVA  
PRIMARY EXAMINER